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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION N
10/092,578	03/08/2002	Tsung Ming Ou	USDP1531T-TB	2823
7590	10/06/2004		EXAMINER WONG, STEVEN B	
Raymond Y. CHAN 1050 Oakdale Lane Arcadia, CA 91006			ART UNIT 3711	PAPER NUMBER 19

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/092,578

Applicant(s)

OU, TSUNG MING8

Examiner

Steven Wong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2004.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-17 is/are pending in the application.
- 4a) Of the above claim(s) 9-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-8 and 13-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 3-8 and 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kralik (4,660,831) in view of Ou (5,759,123). Regarding claims 3 and 13, Kralik discloses a football comprising a ball cover (14) having four elliptical cover pieces sewn edge to edge together, an inflatable bladder (12), a foam backing layer (16) and a construction liner comprising a fabric lining (24) and a sheet material (26) laminated together. Note column 3, lines 12-24 and 33-47 detailing the construction liner. Kralik also states that other liner assemblies may be utilized.

Ou reveals a football construction including a panel formed from a rubber layer and a fabric lining layer which are compressed and vulcanized together. It would have been obvious to one of ordinary skill in the art to the ethylene vinyl acetate sheet of Kralik with a rubber sheet that is compressed and vulcanized with the fabric lining to form the liner piece in order to take advantage of rubber's well known physical characteristics and to form an integral line piece.

Regarding claim 4, the claim is a product by process claim wherein the patentability of the product does not depend on its method of production. See MPEP 2113. The end product produced by the method steps recited in the claim is rendered obvious by the combination of Kralik in view of Ou.

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Regarding claims 5 and 6, Kralik provides fabric linings (24, 28) on both sides of the sheet material (26). Claim 5 is also a product by process claim where the end product is rendered obvious by the combination of Kralik in view of Ou.

Regarding claims 7 and 8, Kralik states that other line assemblies may be utilized. Thus, it would have been obvious to one of ordinary skill in the art to form the construction liner of Kralik as modified by Ou with additional rubber pieces and fabric linings in order to create a stronger liner.

Regarding claim 14, Kralik teaches the use of a backing of foaming material (16). It would have been obvious to one of ordinary skill in the art to form the carcass of Kralik from a synthetic leather material in order to take advantage of that material's well known physical characteristics.

Regarding claim 15, note the rejection of claim 6 above.

Regarding claims 16 and 17, note the rejection of claims 7 and 8 above.

Response to Arguments

3. Applicant's arguments filed June 17, 2004 have been fully considered but they are not persuasive. Regarding the applicant's argument that the teaching of Kralik is totally different from the claimed integral line piece comprising the rubber piece with a fabric lining by compression and vulcanization, the difference is not seen. Kralik provides a football construction comprising a construction liner formed from EVA with a fabric lining laminated thereto. The limitation for the rubber piece to be compressed and vulcanized with the fabric lining relate to the process for making the product and these limitations are anticipated or rendered obvious when presented in an apparatus claim. See MPEP 2113. Further, the rejection

of claim 3 is over the combination of Kralik in view of Ou wherein Ou is relied upon for teaching construction liners comprising a rubber layer and a fabric layer which are compressed and vulcanized together.

Regarding claims 5 and 6, Kralik teaches fabric linings sandwiching the middle layer.

Regarding claims 7 and 8, the number of layers of rubber pieces and fabric linings is considered to be obvious given the teachings of Kralik and Ou and lacking a showing of the criticality for the specific number of layers by a new and unexpected result.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both inventions teach construction liners for footballs. Kralik even suggests the use of different liner assemblies on column 3, lines 38-42. Ou discloses a construction liner including rubber. Ou states that the rubber material firmly unites with the fabric material and provides a tough construction liner that is capable of being easily sewn. All of these reasons would provide a suggestion to one of ordinary skill in the art to replace the EVA material of Kralik with a rubber material.

Regarding the applicant's argument that Kralik does not teach how to integrally unite a rubber piece with a fabric lining, the rejection is over the combination of Kralik in view of Ou. Here, the reference to Ou teaches the use of rubber compressed and vulcanized with a fabric liner

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to form a panel for the football. Ou particularly enumerates various advantages for using rubber, many of which would be applicable to the ball construction of Kralik. The replacement of the EVA material with a rubber material would have been obvious to one of ordinary skill in the art in order to take advantage of rubber's well known physical characteristics. In order for one of ordinary skill in the art to unite the fabric lining with the rubber piece, one of ordinary skill in the art merely looks to the teachings of Ou defining the use of compression and vulcanization to unite a fabric layer with a rubber layer.

Regarding the applicant's argument for commercial success, the Rule 132 Declaration that applicant alludes to was not included in the applicant's reply. However, it should be noted that the applicant has already received several patents directed to very similar embodiments as the one pending. The Declaration for commercial success must prove that only the instant application embodies the footballs that are commercially sold and not any of the embodiments presented in the patents already received by applicant. Otherwise, a Declaration for commercial success would not be persuasive as it would be impossible to delineate exactly what structures of the invention are responsible for achieving applicant's commercial success.


Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Wong whose telephone number is 703-308-3135. The examiner can normally be reached on Monday through Friday 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 703-308-1513. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Steven Wong
Primary Examiner
Art Unit 3711

SBW
September 30, 2004